

REMARKS

Applicant replies to the Office Action dated November 5, 2008. Claims 1-123, 158 and 159 remain pending. Reconsideration of this application in view of the Remarks that follow is respectfully requested.

Summary of Telephonic Interviews

As an initial matter, Applicant thanks the Examiner for the interviews conducted on November 13, 2008 and November 19, 2008 with Applicant's attorney Jamie Sullivan (U.S. Patent Reg. No. 59,165). In the interviews, the Examiner consented to Applicant including the Examiner's requested procedural changes and amendments to the previously submitted claims, as part of the Reply submitted herein.

During the interviews, the parties were unable to reach agreement regarding the rejections of claims 71-123 under 35 U.S.C. § 251. Specifically, the Examiner maintains that the limitation in independent claim 71 of "applying the solution as the travel scheme for minimizing travel costs by purchasing travel trips in accordance with the solution" is surrendered subject matter that is impermissibly recaptured in the present reissue application. For the reasons discussed herein, Applicant respectfully disagrees.

Specification

The Examiner objects to the Abstract because the Examiner contends the amendment filed on 11/7/2006 is not properly amended. Specifically, the Examiner contends the deleted parts should be enclosed in brackets.

Accordingly, Applicant submits an amended abstract showing the deleted subject matter in brackets and the added matter as underlined in accordance with MPEP § 608.01(b) and 37 CFR § 1.173(d)(1). Moreover, in accordance with the request made by Examiner Rimell in the Office Action dated February 27, 2007, a clean version of the Abstract is also included in this Reply on page 32. As such, Applicant submits that the formal matters related to the specification are now in compliance with all statutory requirements and requests withdrawal of this objection.

Oath/Declaration

The Examiner rejects claims 1-123 and 158-159 under 35 U.S.C. § 251 as being based upon a defective reissue oath/declaration. Specifically, the Examiner contends the claims were amended after the oath/declaration was submitted on 5/18/2006. However, the Examiner states that receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection, and provides an example of acceptable language to be used in the oath/declaration.

As such, Applicant herein submits a supplemental oath/declaration signed by the inventor and dated March 24, 2009 which is an approved form from the USPTO website, and contains the language recommended by the Examiner. The oath/declaration is executed subsequent to all amendments to the claims. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 251 rejection of claims 1-123 and 158-159.

Claim Rejections – 35 USC § 251

The Examiner next rejects claims 71-123 under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent, upon which the present reissue is based. Specifically, with respect to independent claim 71, the Examiner contends that Applicant deleted, removed or omitted the limitation of “applying the solution as the travel scheme for minimizing travel costs by purchasing travel trips in accordance with the solution” (hereinafter referred to as the “Claim Limitation”). The Examiner contends the Claim Limitation is surrendered subject matter. Claims 72-123 stand rejected as being dependent upon independent claim 71. For the reasons provided below, Applicant respectfully disagrees and traverses.

As an initial matter, and by way of background, the Claim Limitation was added to claims 1 and 18 in the original application in the Reply to Office Action dated April 17, 1998. The April 17, 1998 Reply was submitted in response to the Office Action dated January 21, 1998, in which claims 1-70 were rejected under 35 U.S.C. § 101 as being directed toward non-statutory subject matter.¹ Specifically, the Examiner stated in the Jan. 21, 1998 Office Action that claims 1-70 lacked (1) a physical transformation outside the computer; or (2) practical

application within the technical arts. *Notably, no art was cited against Applicant in the January 21, 1998 Office Action.*

MPEP § 1412.02 provides a flowchart entitled “Reissue Recapture – Determining its presence or absence,” (hereinafter “Flowchart”) to aid in the determination of whether a rejection due to impermissible recapture is appropriate. The Flowchart is provided herein for ease of reference.

With reference to the Flowchart, if the broadening reissue is filed within two years of the patent grant, for impermissible recapture to be present there must either be: (1) “In the original application, an amendment was made that narrowed the claims to *overcome an art rejection of record*”; or (2) “In the original application, an argument or statement was made by applicant that a specific claim limitation *defined over the art of record*.” Absent these two elements, the Flowchart clearly states “*There is no recapture.*” (Emphasis Added).²

Applicant respectfully submits that the reissue application was filed within two years of the date of issuance of the original application, thus broadening of the claims is permissible under MPEP § 1412.03(IV).

Moreover, as clearly evidenced by the Jan. 21, 1998 Office Action and Apr. 17, 1998 Reply, the Claim Limitation was added to overcome a 35 U.S.C. § 101 rejection, and *not to overcome an art rejection of record*. Moreover, no statements were made by Applicant that the Claim Limitation was added to define over the art of record. To the contrary, Applicant states in the Apr. 17, 1998 Reply, “Applicants [sic] have amended each of the independent claims to variously recite that the solution is applied as the travel scheme for minimizing travel costs by purchasing travel trips in accordance with such solution. *Thus, the claims are now limited to a practical application within the technological arts.*” (Emphasis Added).

For the reasons provided above, Applicant respectfully submits that the Claim Limitation of “applying the solution as the travel scheme for minimizing travel costs by purchasing travel

¹ The Jan. 21, 1998 Office Action and April 17, 1998 Reply are attached herein for reference.

² MPEP § 1412.02 further emphasizes this point. Section 1412.02 states, “If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant.” (MPEP § 1412.02(I)(B)(1)(A) (emphasis added)).

trips in accordance with the solution” is not surrendered subject matter. Accordingly, Applicant respectfully requests withdrawal of the Section 251 rejection of claims 71-123.

Claims

In the Office Action, the Examiner rejects claims 1-123 and 158-159 because the Examiner contends the procedures of amending claims during the period of prosecution of the Reissue Application were not followed. Accordingly, Applicant herein resubmits the Replies requested by the Examiner to correct the informalities.

Specifically, regarding #5 of the Office Action, the Examiner contends the Preliminary Amendment filed on 11/3/2000, which added new claims 71-167 did not provide the explanation for support in the specification for the new claims. Applicant herein resubmits the Preliminary Amendment filed on 11/3/2000 which specifically provides explanation for support for the new claims on page 33. Accordingly, Applicant respectfully requests withdrawal of this basis for rejection.

Regarding #6, the Examiner contends that in the Preliminary Amendment filed on 7/16/2001, which amended claims 124, 141, 160, 163-166 and added new claims 168-172, Applicant did not underline the subject matter of the newly added claims and did not provide the explanation for support in the specification for the amended and new claims. Accordingly, Applicant herein resubmits the Preliminary Amendment filed on 7/16/2001 with the new claims underlined and support for the new claims provided on page 50. Accordingly, Applicant respectfully requests withdrawal of this basis for rejection.

Regarding #7, the Examiner contends that in the amendment filed on 11/18/2004, which amended claims 124-125, 131, 141-142, 148, 160, and 166-170, Applicant did not underline the subject matter of the amended claims and did not provide an explanation for support in the specification for the amended claims. Moreover, Applicant listed claims 71-172 as original even though they were amended in a previous reply. The Examiner further contends the claims should have been listed as “currently amended.” [sic]. Accordingly, Applicant herein resubmits the Preliminary Amendment filed on 11/18/2004 with new elements underlined and claims 71-173 and 158-159 listed as “previously presented” on page 56. Accordingly, Applicant respectfully requests withdrawal of this basis for rejection.

Regarding #8, the Examiner contends that in the Amendment filed on 7/19/2005, Applicant did not underline the remaining claims 71-123 and 158-159 and left the status as

“original” rather than “previously presented.” Applicant herein resubmits the 7/19/2005 Amendment on page 94 to underline any new subject matter and list claims 71-123 and 158-159 listed as “previously presented.” Accordingly, Applicant respectfully requests withdrawal of this basis for rejection.

Regarding #9, the Examiner contends that in the Amendment filed on 5/18/2006, the claims were listed in the same manner as the earlier amendment dated 7/19/2005. Accordingly, Applicant herein resubmits the 5/18/2006 Amendment on page 119 herein to list claims 71-123 and 158-159 listed as “previously presented.” Accordingly, Applicant respectfully requests withdrawal of this basis for rejection.

Regarding #10, the Examiner contends that in the Amendment filed on 8/14/2006, claims 1, 18, 35 and 53 [sic] were amended improperly, because the deleted part was not included in brackets, and claims 71-123 and 158-159 were listed in the same manner as the old amendment dated 7/19/2005. Accordingly, Applicant resubmits the 8/14/2006 Amendment on page 144 herein to enclose the deleted subject matter in claims 1, 18, 35 and 54 in brackets and list claims 71-123 and 158-159 as “previously presented.” Accordingly, Applicant respectfully requests withdrawal of this basis for rejection.

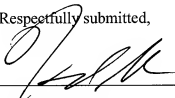
Regarding #11, the Examiner contends that in the Amendment filed on 11/7/2006, 71-123 and 158-159 are listed in the same manner as the old amendment dated 7/19/2005. Accordingly Applicant respectfully resubmits the 11/7/2006 Amendment on page 1169 herein to list claims 71-123 and 158-159 as “previously presented.” Accordingly, Applicant respectfully requests withdrawal of this basis for rejection.

In view of Applicant’s remarks above and the resubmitted Amendments, Applicant respectfully requests withdrawal of the procedural rejections of claims 1-123 and 158-159.

Conclusion

Applicant submits that the application is now in condition for allowance and earnestly requests a Notice of Allowance of claims 1-123 and 158-159. Should the Examiner wish to discuss any of the above in greater detail, then the Examiner is invited to telephone the undersigned at the Examiner's convenience. Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814.

Respectfully submitted,



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